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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,424

03/07/2006

Wolfgang Brunner

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03/12/2009

Roche Molecular Systems, Inc.

Patent Law Department

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EXAMINER

SASAKI, SHOGO

ART UNIT

PAPER NUMBER

1797

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/561,424	<b>Applicant(s)</b> BRUNNER, WOLFGANG	
	<b>Examiner</b> Shogo Sasaki	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/19/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/2006</u> .  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Amendment to claim 6 is acknowledged. Cancellation of claims 12 and 13 is also acknowledged.

#### ***Election/Restrictions***

2. Applicant's election without traverse of Group I in the reply filed on 2/18/2009 is acknowledged.

#### ***Information Disclosure Statement***

3. The information disclosure statement filed 10/27/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the EP search report 06014143.9 was not considered.

4. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The cutting web, 28; the gripper 11; and the gripping jaws 34 in the description of the Fig. 3a/b are not shown in the Fig. 3a/b. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should

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include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

If the cutting web and the gripper in Fig. 3a/b look different from the equivalent parts in Fig. 2a/g, it is suggested to use different numbers for said parts since they have been already used to designate particular parts in Fig. 2a/b. Appropriate correction in the specification may be required.

Although it is intuitively understood, it is suggested use different number for the holes on the middle plate in Fig. 5 a/b since the holes on the middle plate have projections and elongated shape. They are different from the holes in the top and the bottom plate according to the specification.

### ***Specification***

6. It is suggested rephrase "The device according to the invention is provided by the company Sarstedt for the handling of reaction vessels..." in page 7, line 30. It is not clear if the device of instant application has already been available for sale; or if it is the vessels that the instant invention may be useful for is known in the art.

### ***Claims***

7. It is suggested to add "a" before holding device in line 3 of claim 1.

8. It is also suggested to omit "somewhat" from claim 6. It may be considered a relative term which renders the claim indefinite. The specification does specifically state that the middle plate being offset (1.2 mm or less) with respect to the top and bottom holds the vessels in place. However the specification does not explicitly describe how much shift is necessary to hold the specific vessel.

***Claim interpretation***

9. Claim 1 does not positively set forth “reaction vessels” as part of the claimed subject matter. Any further references to said elements were not given patentable weight even if those references further limit said unclaimed element.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Burt et al. (IDS: US 4674340).

Regarding claims 1-5, Burt et al. disclose a device (Fig. 1-6) comprising:

- a holding device (Fig. 1: 4 and 10; and Fig. 2);
- a gripper (74), wherein the gripper has gripping jaws (82) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (64, 66, 68, 70 and 80);
- wherein the gripping jaws have insertion slopes (84);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (88);
- wherein the cutting web projects beyond the gripping surface (Fig. 4 and 5); and
- wherein the holding device has a clamping mechanism (Fig. 2).

Regarding claims 1 and 5, recitations directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art. The process limitations do not have patentable weight in an apparatus claim.

12. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Besnier (IDS: US 5533407).

Regarding claims 1-5, Besnier discloses a device (Fig. 1-7) comprising:

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- a holding device (Fig. 4: 38);
- a gripper (Fig. 6: 76), wherein the gripper has gripping jaws (106) and the gripper has no active operating device for opening and closing the gripping jaws;
- a rotating mechanism for rotatable holding of the gripper (Fig. 6: 74, 88);
- wherein the gripping jaws have insertion slopes (Fig. 6: 106);
- wherein the gripping jaws have on their gripping surfaces one or more cutting webs running at right-angles to the direction of rotation (Fig. 6: 108);
- wherein the cutting web projects beyond the gripping surface (Fig. 6: 106 relative to 108); and
- wherein the holding device has a clamping mechanism (Fig. 4: 40).

Regarding claims 1 and 5, recitations directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art. The process limitations do not have patentable weight in an apparatus claim.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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15. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (IDS: US 4674340) or Besnier (IDS: US 5533407) in view of Marino (IDS: US 6132684).

Regarding claims 6-8 and 11, Burt et al. or Besnier disclose all of the limitations as set forth above. However neither of them teaches the holding device specifically claimed in 6-11.

Marino discloses a holding apparatus for holding resilient plastic tubes (abstract; entire disclosure; and Fig. 1-12) comprising:

- three perforated plates (102, 104 and 106) arranged one above the other as a bottom plate (Fig. 8), a middle plate and a top plate, each of the perforated plates having a plurality of openings (Fig. 1-12), wherein the top and bottom perforated plates are arranged so as to be stationary, with the openings in the top and bottom perforated plates being flush with one another (column 4, lines 13-17; Fig. 6, 8 and 10), and the middle perforated plate is capable of sliding between a first position in which the openings in the middle perforated plate are aligned with the openings of the top and bottom perforated plates, and a second position in which the openings are arranged somewhat offset relative to the openings of the top and bottom perforated plates, so that a reaction vessel inserted in the openings of the perforated plates is immobilized (column 3, line 60-column 11, line 59);
- means for moving and fixing (Fig. 5, 7-9) the middle perforated plate in the second position;
- wherein the middle perforated plate is mounted so as to slide in a single direction of sliding (column 3, line 60-column 11, line 59); and
- wherein the openings in the direction of sliding are wider than those at right-angles to the direction of sliding (column 3, line 60-column 11, line 59).

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Regarding claims 6, recitations directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art. The process limitations do not have patentable weight in an apparatus claim.

Regarding claims 9 and 10, modified Burt et al. or modified Besnier disclose all of the limitations as set forth above. However neither of them teach the projections provided in the holes of the plates, which extend into the interior of said holes.

Burt et al. and Besnier both teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections). The projections are merely provided for giving the extra traction/friction to firmly hold the tubes in place. The very idea is already taught by both Burt et al. and Besnier.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the same idea to the vessel holding side. The claim would have been obvious because "a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense."

16. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burt et al. (IDS: US 4674340) or Besnier (IDS: US 5533407) in view of Marino (IDS: US 6132684), and further in view of Hansen et al. (US 2003/0038071).

Regarding claims 9 and 10, modified Burt et al. or modified Besnier disclose all of the limitations as set forth above, however does not explicitly show the projections provided at the holes of plates. Burt et al. and Besnier both teach the projections provided at the cap/lid contacting side of the cap/lid holding means (See 102 rejections).

Hansen et al. disclose a holding apparatus similar to the one disclosed by Marino (See Fig. 2-5 and 14-20). The holes (142) on plates of Hansen et al. include edges 144 which are configured to engage with projections 146 on the exterior of the tubes 120 to prevent the tubes 120 from rotating within the openings 142 when, for example, a cap (not shown) is being screwed onto a top of the tube 120 ([0041]).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of modified Burt et al. or modified Besnier to incorporate projections as taught by Hansen et al., for the purpose of giving extra



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traction to hold the tubes in place. The claim would have been obvious because the technique for improving a particular class of devices was part of the ordinary capabilities of a person of ordinary skill in the art, in view of the teaching of the technique for improvement in other situations.

### ***Conclusion***

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shogo Sasaki whose telephone number is (571)270-7071. The examiner can normally be reached on Mon-Thur, 10:00am-6:30pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SS

3/10/09

/Brian R Gordon/

Primary Examiner, Art Unit 1797